



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,053	07/26/2001	William John Waywood	A1019/20276	7279

7590 10/31/2002

Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd.
Seven Penn Center
12th Floor
1635 Market Street
Philadelphia, PA 19103-2212

EXAMINER

ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
----------	--------------

1771

2

DATE MAILED: 10/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MA-2

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-50 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-50 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1771

1. The Examiner notes that applicant has inadvertently submitted claims numbered 1-37 and 39-51, with no claim 38 present in the application. Accordingly, the claims have been renumbered as 1-50, pursuant to Rule 126.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-50 are rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. More particularly, applicant's specification appears to teach at page 3 lines 7-15 and also at page 11 lines 19-21 that the presence of a migratory slip agent which is an amide, together with the fact that the additive in the slip layer is an antistatic agent, are each critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

4. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences

between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over applicant's admissions concerning the prior art set forth at page 3, lines 7-15 taken in view of Frognet et al. Applicant appears to admit in the cited section of the specification that the claimed structure in both independent claim 1, which includes an antistatic additive in an outer skin layer and a migratory amide in the core layer is known, and also that the basic structure set forth in claim 28 except for the presence of the antistatic additives and the migratory amides in the outer skin layer and core layer is otherwise known label structure that can be found in the prior art. That is, such elements as the presence of biaxially oriented polyolefin films, films having printing thereon and coated with a suitable outer adhesive are known. The secondary reference Frognet et al., however discloses (note particularly column 9 line 7 - column 10 line 17, as well as the Abstract and column 11 lines 32-48) the alleged previously missing motivation to incorporate an antistatic additive in an outer skin layer and a migratory amide in core layers of this type so as to reduce the coefficient of friction at the surface of the skin layer or

Art Unit 1771

layers in such structures as packaging films and labels. Note particularly column 9 lines 10-15 and column 10 lines 9-12 for such teachings. Additionally, Frognet et al. further teaches that a wide variety of antistatic agents and migratory slip agents, at least several of which are believed employed by applicant can be utilized in the films of the invention. Finally, note also that the secondary reference further indicates that in such films printing inks and suitable adhesives such as hot melts can also be employed (note, e.g. column 11 lines 32-48). With respect to the ^{remaining} dependent claims, these are each believed to be, if not either expressly or inherently disclosed in the relied upon combination, well known conventional additives or obvious optimization parameters such as the particular range of adhesion levels and COF values, in the absence of unexpected results.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Williams and Balaji et al.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

Serial No. 09/916,053

-5-

Art Unit 1771

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

October 29, 2002

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zinker